

REMARKS

Applicant's claims were rejected under the recapture doctrine and the recent Federal Circuit case Pannu v. Storz Instruments, Inc., 258 F.3d 1366 (Fed. Cir. 2001).

5 The Federal Circuit has enunciated seemingly straightforward rules with respect to recapture.

10 The recapture rule "prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims." Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. Reissued claims that are broader than the original patent's claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible. Id. (quoting Mentor, 998 F.2d at 996, 27 USPQ2d at 1525). Application of the recapture rule is a three-step process. The first step is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims." Id. "The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter." Id. Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. Hester, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; Clement, 131 F.3d at 1470, 45 USPQ2d at 1165.

Pannu, at 1370-1.

20 However, application of these rules remains far from straightforward. Nevertheless, while Federal Circuit jurisprudence may not draw bright lines as to when added-in-prosecution features may be claimed differently in a reissue application, the extremes are clear. First, an element added to gain allowance can not be entirely vitiated. That would allow the applicant to recapture *precisely* what was surrendered. Secondly, 25 however, the applicant can not be required to maintain *in its entirety* a limitation just because that limitation was added in prosecution. The Federal Circuit cases do not go so far, and indeed such a position would be in direct conflict with 35 USC § 251, which allows broadening reissues. Indeed, the reissue statute does not include exceptions for limitations added in prosecution.

30 The Pannu case arguably increases the nexus required between the omitted

surrendered material and the limitations added by the applicant's narrowing amendment. Accordingly, in this response, applicant further explains the close nexus between applicant's reissue claim limitations and the subject matter surrendered during prosecution.

5 In Pannu, the applicant added a limitation specifying details of the shape of the lens haptics and argued that the prior art did not show this particular shape. In particular the applicant added the limitation that the shape was a "continuous, substantially circular arc". In the reissue application at issue in Pannu, this limitation was removed, and a limitation related to the "snag resistant means" was added.

10 The Federal Circuit reasoned that the narrowing amendment made and argued in prosecution related to the lens shape. The Court stated that the limitation added during the reissue related to the "snag resistant means" and particularly its positioning and dimensions. Since the narrowing limitation was not related to the broadening, the claim was found invalid. Pannu had attempted to "recapture the precise limitation he added to
15 overcome prior art rejections." Pannu at 1371 (emphasis added).

In contrast, applicant is not attempting to recapture the precise limitation that applicant surrendered.

The difficulty in applying the recapture rule in this case was also present in Pannu, but was arguably easier to reconcile due to the claim structure and the invention
20 being claimed. The difficulty lies in drawing the lines around what the narrowing amendment "relates to". Pannu argued that the narrowing amendment related to the configuration of the haptics. According to Pannu, the snag resistant means was a part of the configuration of the haptics. Therefore, Pannu's position was that one

“configuration” limitation (continuous, substantially circular arc) had been removed in favor of another “configuration” limitation (snag resistant means details).

In contrast, the Court found that the amendment related to the “shape” of the haptics. Since the snag resistant means was found to not be a “shape” limitation, there
5 was no narrowing language related to the shape to save the claim. In Pannu, the analysis was somewhat straightforward since the added limitation was fairly easy to understand. It was a stretch to argue that “continuous, substantially circular arc” is a configuration limitation, and more natural to find that it is a shape limitation.

This contrast between an applicant’s position and the opposing side is always
10 possible in a reissue case. If the applicant defines the nature of what the narrowing amendment “relates to” broadly, then the applicant then has a wider variety of limitations that can be added without violating the recapture rule. If the opponent convincingly argues that the narrowing amendment “relates to” a narrow aspect, then the applicant has less liberty to substitute limitations for the omitted one.

15 Thus, a point of difficulty in the present application is defining what the narrowing amendment “relates to”. Applicant has previously argued that the narrowing amendment relates to the characteristics of power management software. Applicant noted that the “virtual device driver” characteristic was removed, and other characteristics were added, such as the software being able to power manage configurable devices.

20 The difficulty in defining what the narrowing amendment relates to is further confounded by the fact that the narrowing amendment (adding “virtual” to modify device driver) merely added a name, rather than adding any structural elements. Therefore it was only implicitly that applicant added limitations specifying characteristics of the

power management software by specifying “virtual device driver”. Accordingly, it is necessary to consider what is specified when one specifies that a piece of software is a “virtual device driver”.

Microsoft’s on-line glossary, provides the following definition for Virtual Device

5 Driver:

VxD Virtual device driver. A device driver that runs at the privileged ring 0 protected mode of the microprocessor. Can extend the services of the Windows kernel, supervise hardware operations, or perform both functions. Such driver files are usually named according to the scheme VxD, where x refers to the device or service supported.

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<http://www.microsoft.com/hwdev/GLOSSARY2.HTM#V>. Notably, there are numerous “possibilities” and only a few requirements. Power management software that is a virtual device driver “runs at the privileged ring 0 protected mode of the microprocessor.” The power management software can extend the services of the Windows kernel, or can
15 supervise hardware or can do both. Neither extending the services of the kernel, nor supervising hardware is required, and the naming convention is also permissive.

If applicant had removed the phrase “virtual device driver” and replaced it with its definition, no violation of the recapture rule could have occurred. However, such permissive language as given in the definition is traditionally unsuitable for claim
20 language (claims typically don’t claim X, or Y, or both and don’t typically claim that something “usually” has a particular characteristic).

Applicant has instead added limitations related to running at the privileged ring 0 protected mode of the microprocessor and numerous limitations relating to supervising hardware (more specifics below). These limitations clearly do relate to the “virtual
25 device driver” limitation because they are aspects of a virtual device driver called out in the definition of “virtual device driver”. Applicant has difficulty imagining a clearer case

of correlation between the surrendered subject matter and the added limitation. Indeed, the added limitations are clearly within the definition of the removed limitation.

Supervising Hardware Operations

5 In particular, some of applicant's newly added claims specify limitations relating to power managing configurable devices or reconfiguration (e.g., independent claims 51, 57, 64, 70, 73, 74, 80, 86, 94). Power management includes the tasks of observing operations of and/or at least interfacing with a device to place that device in different power consumption states. "Supervise" means "to direct or oversee (employees, 10 machines, or the like) during the performance of a task; superintend." <http://www.wordsmyth.net>. Thus, the fact that applicant's software power manages configurable devices means that it directs or can direct those devices to adjust power states. Such direction constitutes supervision.

Moreover, some claims detail that idle timers and the like are used to monitor 15 when operations occur for such hardware devices (e.g., claims 59, 71, 89-91). Clearly such idle timers and the related power managing constitute supervision of the hardware operations.

Thus, applicant has added a limitation directly and closely related to the omitted limitation of virtual device driver. The power management of configurable devices 20 specifies a detail of the supervision being performed by the power management software. The software is capable of interfacing with configurable devices (the materiality of this limitation was discussed in depth a prior response), being able to direct them to change power states. This supervision is part of what makes a virtual device driver a virtual

device driver. Thus, by addition of this limitation, applicant has retained this aspect of the limitation “virtual device driver”. Applicant therefore can not be said to have completely removed the virtual device driver limitation, or as the Court in Pannu stated, recaptured the “precise limitation” surrendered. Instead, applicant has retained some
5 aspects of the “virtual device driver” limitation and indeed provided details that are narrower than the broad definition of “virtual device driver”.

Privileged, Ring 0 Operation

Additionally, various ones of applicant’s claims (e.g., 52, 54, 70, 73, 79, 85, 92)
10 recite that kernel level operation is still present. This limitation is also directly related to the definition of virtual device driver, and appears to be a key portion of that definition. Thus, claims which add this limitation retain even more of the “virtual device driver” definition and further bolster the position that applicant did not entirely remove the virtual device driver limitation nor recapture the “precise limitation” surrendered.

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Extended Services

Another aspect of the definition of “virtual device driver” is that extended services may be provided to an operating system via such software. This is another aspect retained in some of applicant’s claims. For example, claims 53, 55, 67, 76, 82 and 93
20 recite that a plug and play manager is provided. A plug and play manager helps to manage plug and play devices and would not be required to have an operating system. Therefore, providing a plug and play manager constitutes an operating system service extension. Additionally, some claims recite details of data structures, registration, and

the like, additional operating system services.

Lack of Permanent Ties to a Specific Hardware Device

Also worthy of note is that applicant is not trying to back away from the reasons
5 the Examiner gave for the original application's allowance. Applicant's "configurability"
limitations are consistent with lacking permanent ties to a specific hardware device. If a
hardware device was completely permanently tied to an operating system routine, it could
hardly be thought to be configurable. Since applicant's power management software
claimed in some claims can power manage a configurable device, it lacks permanent ties
10 to that specific hardware device, and allows that device to be configured in various ways.
Moreover, claim 63 specifically calls out this limitation. Thus, applicant is not
attempting to re-claim that which the Examiner believed needed to be surrendered in
order to gain allowance of the original application.

15 Materiality of Limitations

Applicant previously set forth in great detail, in chart format, reasons why
applicant's added limitations are material. Applicant respectfully requests the chart filed
with applicant's second previous response be consulted if any concerns regarding the
materiality of these amendments arise. Indeed, apparently this chart was convincing as
20 the claims were indicated to be allowable until the Federal Circuit decided Pannu.

Conclusion

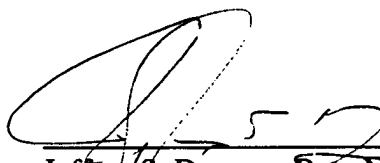
Applicant has shown how the limitations that applicant has added are directly

related to and in some regard narrower than the limitation added in prosecution of US Patent 5,590,342, but now partially omitted in the present reissue application. In some cases, the omission of virtual device driver amounts to no more than the removal of a name, as all other mandatory and permissive elements of virtual device driver are maintained in some claims (see, e.g., claim 73). In other claims, at least one key aspect of what makes a virtual device driver just that, a virtual device driver, is claimed in more detail than required by the definition itself. Therefore, because applicant has materially narrowed applicant's claims in a manner directly pertinent to the limitation added in prosecution of the original application, removal of that limitation is permissible.

Applicant submits that all claims now pending are in condition for allowance. Such action is earnestly solicited at the earliest possible date. If there is a deficiency in fees, please charge our Deposit Acct. No. 02-2666.

Respectfully submitted,

Date: 1/8/02


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